

REMARKS

This is in response to the Office Action dated December 5, 2005. Because this response is mailed on March 6, 2006 (March 5 being a Sunday), the response is timely filed.

I. Status of the Claims

Claims 29-54 were pending prior to this amendment. Claims 29, 35, 41, 42, 43 and 49 have been amended. Thus, claims 29-54 remaining pending.

II. Response to December 5 Office Action

In the December 5 Office Action, pending claims 29-54 were provisionally rejected for alleged obviousness-type double patenting over co-pending application No. 09/686,308 (the “’308 application”), and were provisionally rejected under 35 U.S.C. 102(e) as allegedly anticipated by the ‘308 application. Additionally, issues relating to the inventorship of the claimed subject matter were raised. Applicants respectfully disagree.

A. The rejections should be withdrawn

As an initial matter, applicants note that the ‘308 application has issued as U.S. Patent No. 6,981,635 (“the ‘635 patent”). Consequently, applicants will address their comments to the description and claims of the ‘635 patent.

As to the rejections, both are premised on the allegation that each and every limitation of the claimed subject matter can be found in the specification or the claims of the ‘635 patent. Applicant submits that each of the independent claims of the present application include at least one limitation that is not disclosed in the specification or recited in the claims of the ‘635 patent. Consequently, these rejections should be withdrawn.

For example, claim 29 recites a method of conducting a slots game. The method includes receiving a wager, displaying a plurality of symbols arranged in a plurality of reels, displaying at least one interactive symbol, receiving a player selection of a selected symbol

from the plurality of symbols, and transforming the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol. The method also includes determining a payout associated with a configuration of symbols including the transformed symbol and at least one other symbol of the plurality of symbols, the at least one other symbol other than the at least one interactive symbol and the transformed symbol.

As for these limitations, applicant submits that at least the last limitation of claim 29 is not found in the specification or the claims of the '635 patent. An exemplary embodiment illustrating this subject matter is included in Figs. 5C and 5D, and is discussed in paragraph [0052]. As will be recognized, the transformed symbol and at least one other symbol from the plurality of symbols (which are arranged on the plurality of reels) are used to determine the payout in such an embodiment, and may result in payouts not possible when the plurality of symbols is initially displayed.

By contrast, the specification of the '635 patent does not disclose such a determination. In the '635 patent, a payout is made in association with one or both of the interacting symbols. See, e.g., col. 1:65-2:2; col. 2:12-14, 28-30; col. 6:35-40; col. 7:10-13, 27-31, and 58-61. There is no determination or consideration of a configuration defined by an allegedly corresponding transformed symbol (selected from the plurality of symbols) and another symbol of the plurality of symbols, nor is there a payout awarded based on such a determination or consideration.

Additionally, the claims of the '635 patent do not include recitation of this limitation. Certain claims (for example, claims 28, 38, and 41) recite that the award is associated with the first and second interacting symbols or the set of interacting symbols. Other claims (for example, claims 7, 24, 30 and 31) recite association of an award with one of the interacting symbols. However, applicants submit that none of the claims recites that the award is associated with a combination of an interacting symbol and a symbol from the plurality of symbols that is not one of the interacting symbols. Consequently, these claims do not recite each and every limitation of the presently claimed subject matter.

Applicants submit that each and every limitation of claim 29 is not disclosed in the specification of the '635 patent, or recited in the claims of the '635 patent. Therefore, the rejections should be withdrawn.

In regard to independent claims 41 and 43, applicants note similarities between the language of claim 29 and those claims, which similarities make the arguments raised above applicable to claims 41 and 43 as well. In particular, claim 41 recites, in pertinent part, "determining a payout associated with a set of symbols including the transformed symbol and at least one other symbol of the plurality of symbols, the at least one other symbol other than the at least one interactive symbol and the transformed symbol, arranged along . . . at least one payline." Claim 43 recites, in pertinent part, "the microprocessor programmed to determine a payout associated with a configuration of symbols including the transformed symbol and at least one other symbol of the plurality of symbols, the at least one other symbol other than the at least one interactive symbol and the transformed symbol." To the extent that the limitation of claim 29 discussed above is neither disclosed in the specification nor recited in the claims of the '635 patent, then these limitations of claims 41 and 43 are also neither disclosed nor recited. Consequently, the rejections of claims 41 and 43 should also be withdrawn.

As for the remaining claims, they depend from one of independent claims 29, 41, and 43. Given that the rejections should be withdrawn relative to claims 29, 41, 43, then, at least for this reason, the rejections should be withdrawn from the remaining claims.

B. The inventorship issue should be withdrawn

As shown above, the '635 patent claims do not recite the same subject matter as the claims of the present application. At least one limitation is recited in the claims of the present application that is not present in the claims of the '635 patent. Consequently, applicants submit that there is no inventorship issue to be resolved.

Applicants would point out that while the present application and the '635 patent are presently assigned to a common assignee, IGT, the applications were not assigned to the

common assignee at the time of filing. The present application was assigned by the co-inventors to Anchor Gaming. Anchor Gaming later assigned the application to IGT.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 13-2855, under Order No. 29757/AG47. A duplicate copy of this paper is enclosed.

Dated: March 6, 2006

Respectfully submitted,

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